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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,430	10/04/2005	David Jeal	P08620US00/BAS	8714
881 7590 08/11/2009 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER HENNING, MATTHEW T	
			ART UNIT 2431	PAPER NUMBER
			MAIL DATE 08/11/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/531,430

**Applicant(s)**

JEAL ET AL.

**Examiner**

MATTHEW T. HENNING

**Art Unit**

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/29/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1                   This action is in response to the communication filed on 5/21/2009.

2                   **DETAILED ACTION**

3                   Applicant's arguments filed 5/21/2009 have been fully considered but they are not  
4                   persuasive.

5                   The objection to the specification has been maintained due to the improper use of the  
6                   Trademarks BLUETOOTH and SMARTMEDIA. Each use of these trademarks should be  
7                   accompanied by the generic terminology where ever it appears.

8                   Regarding the applicants' argument that Ohashi does not teach the newly claimed  
9                   limitations which requires that the authentication process for authenticating the transaction by  
10                  that user with the data processing apparatus not requiring use of the user's telecommunications  
11                  terminal, or authentication of the telecommunications terminal, the examiner does not find the  
12                  argument persuasive. While the new limitations have been addressed below, the examiner  
13                  provides the following brief explanation. Previously, the examiner had relied upon the client  
14                  terminal 12 as reading on both the data processing apparatus, and the user's telecommunications  
15                  terminal. However, as Col. 11 Lines 30-33 disclose that while only one terminal 12 is shown in  
16                  figure 6, "in fact there may be a plurality of client terminals having the similar constitution as the  
17                  terminal 12 and connected via respective communications lines." As such, the examiner is now  
18                  relying upon one of the other client terminals as reading upon the "user's telecommunications  
19                  terminal" and the client terminal 12 as reading upon the data processing apparatus. Therefore,  
20                  the examiner does not find the argument persuasive.

All objections and rejections not set forth below have been withdrawn.

Claims 1-53 have been examined.

***Specification***

The disclosure is objected to because of the following informalities:

The disclosure lacks section headings.

The use of the trademarks BLUETOOTH and SMARTMEDIA have been noted in this application. It should be capitalized wherever it appears **and be accompanied by the generic terminology.**

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

The examiner encourages the applicants to carefully check the specification to ensure that no other trademarks have been used without proper capitalization and accompaniment by the generic terminology.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

Claims 1-3, 5, 14-17, 19-23, 25, 34-38, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as Ohashi.

Regarding claims 1, 21, and 42, Ohashi disclosed a device (card reader 11) for connection to a data processing apparatus (client terminal 12), the device (card reader 11) including authentication storage means (smart card 10) operatively coupled thereto for storing predetermined authentication information respective to a user (Ohashi Col. 12 Lines 1-29), the authentication storage means (smart card 10) being registered with a telecommunications system (authentication center) which includes authenticating means (AuC data) and for which the user has a telecommunications terminal (other client terminal; Col. 11 Lines 30-33), the device (card reader 11), when operatively coupled to the authentication storage means (smart card 10), being responsive to an input message for deriving a response dependent on the input message and on the authentication information for enabling the authenticating means (AuC data) to carry out an authentication process via a communication link (network 13) with the authenticating means (AuC data) in the said telecommunications system (authentication center) whereby to authenticate a subsequent transaction by the user with the data processing apparatus (client terminal 12) (Ohashi Col. 12 Lines 1-29), and which involves use of the data carded by the authentication storage means (smart card 10) (Ohashi Col. 12 Lines 1-29), the predetermined authentication information stored by the authentication storage means (smart card 10) corresponding to information which is used to authenticate the user registered with the telecommunications system (authentication center) in relation to use of that users telecommunications terminal in the telecommunications system (authentication center) (Ohashi

Col. 12 Lines 1-29), but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of the user's telecommunications terminal (Ohashi Col. 12 Lines 1-29) nor requiring the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications system (Ohashi Col 12 lines 1-29), and wherein the device controls access to the authentication information (Ohashi Fig. 6 wherein all communications in and out of the smartcard pass through the reader/writer).

Regarding claims 2 and 22, Ohashi disclosed security data entry means for obtaining security data independently of the data processing apparatus, and means for analyzing the entered security data for determining whether to allow access to the predetermined information (Ohashi Col. 12 Lines 1-29).

Regarding claims 3, and 23, Ohashi disclosed wherein the data entry means comprises alphanumeric data entry means (Ohashi Col. 12 Lines 1-29).

Regarding claims 5, 25, and 43, Ohashi disclosed that the security data comprises a Personal Identification Number (PIN) and the analyzing means compares the PIN obtained by the security data entry means with a PIN stored on the authentication storage means and only allows access to the predetermined information when the respective PINs match (Ohashi Col. 12 Lines 1-29).

Regarding claims 14 and 34, Ohashi disclosed that each user is authenticated in the telecommunications system by use of a subscriber identity module, and in which the authentication storage means respective to that user corresponds to or simulates the subscriber identity module (Smartcard) for that user (Ohashi Col. 12 Lines 1-29).

Regarding claims 15, and 35, Ohashi disclosed that the transaction is a transaction involving use of data processing functions of the data processing apparatus (Ohashi Col. 12 Lines 30-36).

Regarding claims 16, and 36, Ohashi disclosed that the authentication storage means is specific to that device (Ohashi Col. 11 Lines 65-67).

Regarding claims 17, and 38, Ohashi disclosed that the authentication process involves the sending of a message and the generation of a response dependent on the message and the predetermined information (Ohashi Col. 12 Line 55 – Col. 13 Line 10).

Regarding claims 19 and 20, see Ohashi Fig. 1.

Regarding claim 37, Ohashi disclosed that the authentication storage means is associated with the data processing apparatus by being associated with data or software for use by that data processing apparatus (Ohashi Col. 12 Lines 1-29).

Regarding claim 41, Ohashi disclosed that the data processing apparatus is a personal computer (Ohashi Col. 5 Paragraph 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

Claims 18, 39-40, 46-51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi.

Regarding claims 18, and 39-40, while Ohashi disclosed providing a network service, Ohashi fails to disclose the system levying a charge for the service transaction. However, it was well known in the art of service providing to levy charges for providing the service. As such, it would have been obvious to the ordinary person skilled in the art at the time of invention to have had the system levy a charge for the service. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the service provider with compensation for the service.

Regarding claims 46, 49, and 53, while Ohashi disclosed the smart card communicating with a smart card reader, Ohashi failed to disclose the communication being wireless. However, it was well known at the time of invention for smart cards to communicate wirelessly. As such, it would have been obvious to the ordinary person skilled in the art at the time of invention to have provided the communications wirelessly. This would have been obvious because the ordinary person skilled in the art would have been motivated to increase the ease of use for the user.

Regarding claim 47, 48, 50 and 51, while Ohashi disclosed the smart card operable in a general purpose personal computer and authenticating the computer for use in the system, Ohashi failed to disclose that the computer could be a mobile computer. However, mobile computers, such as laptops, pda's, and telephones were well known in the art at the time of invention. As such, the ordinary person skilled in the art at the time of invention would have found it obvious to modify Ohashi to include laptops, pda's telephones, and other such known mobile computers. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the user with more flexibility and ease of access.



Claims 4, 6-13, 24, 26-33, 44-45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi as applied to claims 1, 21, and 42 above, and further in view of Caputo et al. (US Patent Number 5,778,071) hereinafter referred to as Caputo.

Regarding claims 4, 6, 24 and 26, while Ohashi disclosed a smart card reader, and entry of PIN numbers, Ohashi failed to disclose the smart card reader having a keypad or a display.

Caputo teaches, in Fig. 1E and Col. 7 Lines 37-61, a smart card reader which has a keypad and a display far facilitating the entry of PIN numbers.

It would have been obvious to the ordinary person skilled in the art at the time of invention to have employed the teachings of Caputo in the smart card system of Ohashi by utilizing the smart card reader of Caputo. This would have been obvious because the ordinary person skilled in the art at the time of invention would have been motivated to provide a specific means for the entry of PIN numbers, as generically suggested by Ohashi.

Regarding claims 7 and 27, Ohashi and Caputo taught a data processing module for controlling the communication with the data processing apparatus (See Caputo Fig. 2 Element 172).

Regarding claims 8 and 28, Ohashi and Caputo taught that the data processing module of the device is configured for communicating with a corresponding data processing module of the data processing apparatus (Caputo Fig. 5A).

Regarding claims 9 and 29, Ohashi and Caputo taught that communication between the authentication storage means and the data processing apparatus is performed via the respective data processing modules (Caputo Fig. 2).

Regarding claims 10, 30 and 44, Ohashi and Caputo taught that the data processing module of the device includes means for decrypting encrypted data received from the data processing module of the data processing apparatus (Ohashi Col. 12 Lines 30-36 and Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Regarding claims 11, 31, and 45, Ohashi and Caputo taught the data processing module of the device includes means for encrypting data transmitted to the data processing module of the data processing apparatus (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Regarding claims 12, 32, and 52, Ohashi and Caputo taught that the respective data processing modules comprise a key for allowing encryption and/or decryption of data (Caputo Fig. 6).

Regarding claims 13, and 33, Ohashi and Caputo taught that the key comprises a shared secret key for each of the respective data processing modules (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

#### ***Conclusion***

Claims 1-53 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

1 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period  
2 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37  
3 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,  
4 however, will the statutory period for reply expire later than SIX MONTHS from the mailing  
5 date of this final action.

6 Any inquiry concerning this communication or earlier communications from the  
7 examiner should be directed to MATTHEW T. HENNING whose telephone number is  
8 (571)272-3790. The examiner can normally be reached on M-F 8-4.

9 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
10 supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the  
11 organization where this application or proceeding is assigned is 571-273-8300.

12 Information regarding the status of an application may be obtained from the Patent  
13 Application Information Retrieval (PAIR) system. Status information for published applications  
14 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
15 applications is available through Private PAIR only. For more information about the PAIR  
16 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR  
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18 like assistance from a USPTO Customer Service Representative or access to the automated  
19 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

20  
21 /Matthew T Henning/  
22 Examiner, Art Unit 2431